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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/745,669 | 12/21/2000 | Brian M. Siegel | 50N3787 | 5754 |
| 27774 7590 03/25/2009 MAYER & WILLIAMS PC 251 NORTH AVENUE WEST 2ND FLOOR WESTFIELD, NJ 07090 | | | | |
| EXAMINER ZURITA, JAMES H | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3625 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 03/25/2009 | | PAPER | | |

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN M. SIEGEL and
THOMAS MARCHESELLO

Appeal 2008-5598
Application 09/745,669
Technology Center 3600

Decided:¹ March 25, 2009

Before ANTON W. FETTING, JOSEPH A. FISCHETTI, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1, 5-7, 28, and 31-32 which are all the pending claims in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We AFFIRM-IN-PART.

THE INVENTION

The Appellants' claimed invention is directed to integrating a bar code scanning and information retrieval system into a consumer electronic device [0013]. Claims 1 and 7, reproduced below, are representative of the subject matter of appeal.

1. An apparatus for retrieving information related to a consumer product using a consumer product codes comprising:

a) a portable consumer good that lacks the capacity for data transmission, wherein said portable consumer good comprises a non-electronic device; and

b) a scanning and storage device incorporated into said portable consumer good, said scanning and storage device including:

(i) a scanning element converting a product code symbol into machine readable information representative of said product code; and

(ii) a removable memory medium to which said information is stored.

7. An apparatus for retrieving and processing information related to a consumer product using a universal product code comprising:

a) a portable consumer device, said portable consumer device including:

(i) a portable consumer good comprising a non-electronic device that lacks the capacity for data transmission; and

(ii) a scanning and storage device incorporated into said portable consumer good, said scanning and storage device comprising:

(1) a scanning element converting a printed universal product code symbol into machine readable information representative of said universal product code; and

(2) a removable memory medium to which said information is stored; and

b) an Internet-ready device couplable to one or more Internet-based information servers, said Internet-ready device including a removable memory medium adapted to accept said removable memory medium from said scanning and storage device.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

| | | |
|--------|-----------------|---------------|
| Schena | US 6,448,979 B1 | Sep. 10, 2002 |
| Kocher | US 6,652,455 B1 | Nov. 25, 2003 |

The following rejections are before us for review:

1. Claims 1, 5-7, 28, and 31-32 are rejected under 35 U.S.C. § 103(a) as unpatentable over Schena and Kocher.

THE ISSUE

The issue is whether the Appellants have shown that the Examiner erred in making the aforementioned rejections.

With regards to claims 1 and 5-6 this issue turns on whether it would have been obvious to combine Schena and Kocher to obtain the claimed limitation for a “removable memory medium to which said information is stored.”

With regards to claim 7 this issue turns on whether it would have been obvious to combine Schena and Kocher to include the limitation for “an Internet-ready device couplable to one or more Internet-based information servers, said Internet-ready device including a removable memory medium adapted to accept said removable memory medium from said scanning and storage device.”

With regards to claims 28 and 31-32 this issue turns on whether it would have been obvious to combine Schena and Kocher to include the limitation for “transferring the scanned bar code from the removable memory to a computer network; and accessing a web site on a computer network based on the scanned bar code.”

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:²

FF1. Schena discloses a scanner 100 for machine readable code 10 which uses memory 110 (Abstract, Figure 1).

² See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF2. Schena discloses that the scanner 100 stores a code file in memory 110 representing codes scanned by the operator (Col. 5:34-37).

FF3. Schena does not disclose both a separate consumer good and an Internet-ready device adapted to accept the removable memory medium.

FF4. Schena does not disclose transferring the scanned bar code from removable memory to a computer network and then accessing a web site on a computer network based on the scanned bar code.

FF5. Kocher discloses a scanning tool for foods and medicines (Abstract).

FF6. Kocher discloses that scanned data is related to the respective product in memory modules 22 which are removable (Col. 5:25-28).

FF7. Kocher does not disclose both a separate consumer good and an Internet-ready device adapted to accept the removable memory medium.

FF8. Kocher does not disclose transferring the scanned bar code from removable memory to a computer network and then accessing a web site on a computer network based on the scanned bar code.

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called

secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). See also *KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S. Ct. at 1739, (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 1739. The Court also stated “[i]f a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 1740. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.* at 1741 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

ANALYSIS

Claims 1 and 5-6

The Appellants argue that the rejection of claim 1 is improper because Schena and Kocher do not teach or suggest a removable memory medium for storing information related to a scanned product code that can be stored in an Internet-ready device or a device that lacks the capacity for data transmission (Br. 7-8). The Appellants argue that Kocher's device teaches the use of removable memory for information related to the product scanned, but not the product code symbol that is scanned (Br. 8).

In contrast the Examiner has determined that Schena's device would have been obvious to combine with the removable memory of Kocher to provide an old and well known option (Ans. 4).

We agree with the Examiner. We first construe the meaning of the term "removable memory medium" as used by the Appellants in the claims. We determine the scope of the claims in patent applications "not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction 'in light of the specification as it would be interpreted by one of ordinary skill in the art.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (*en banc*) (quoting *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)). The Specification at page 12 in describing the removable memory states:

[0039] *In some embodiments, upon scanning a bar code, the processor 12 automatically stores the bar code in the removable memory 13. Shown in FIG 2, the removable memory can be a card inserted into a slot 22 on an edge of the consumer electronic device 10.*

[0040] The *removable memory may be any memory type that can be easily removed from one device and inserted in another*. Some examples include smart cards, removable disk drives, diskettes, re-writable CD-ROMS, cards with magnetic strips, magnetic discs, flash memory, random access memory chips and memory sticks. The removable storage medium (also referred to herein as removable memory medium) can be removed from the scanning device 10 and inserted into an Internet-ready device 30 (see, e.g., FIG 3, discussed further below).

(Specification [0039-040], emphasis added).

Here, the Specification states that the *removable memory may be any type of memory that can be easily removed*, and no exclusive removable memory such as a card or memory stick is disclosed. Thus, claim 1 only requires that the “memory is removable” when given its broadest reasonable interpretation in light of the Specification. The scope of the claims is not limited to a memory card or stick, but simply to any “removable memory medium.” The scope of the phrase “a removable memory medium to which said information is stored” does not require that the information is stored “permanently,” the scanned UPC information may be just stored “temporarily” while matched with the information for the UPC code. In Schena some memory device must hold the scanned UPC code at least temporarily in memory while the UPC code is matched to the UPC code information. Here, Schena discloses a scanner 100 for machine readable code 10 which uses memory 110 (FF1). Schena discloses that the scanner 100 stores a code file in memory 110 representing codes scanned by the operator (FF2). Kocher discloses a scanning tool for foods and medicines (FF5). Kocher discloses that scanned data is related to the respective

product in memory modules 22 which are removable (FF6). The modification of Schena to include removable memory for any portion of the device, including the portion in Schena that holds the UPC code, as disclosed by Kocher is considered an obvious predictable use of prior art elements according to their established functions for the known advantage of having memory modules which could be easily transported, replaced, and expanded as necessary and conventionally known in the art. With regards to the Appellants' argument that the claim requires "the lack of capacity for data transmission" we note that some data is transferred in any scanning device internally, including the Appellants' own invention. Regardless, the modification of the system to not have the capacity for data transmission is considered a known expedient to reduce costs if desired. For the above reasons the rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over Schena and Kocher is sustained. The Appellants have not argued the rejection of claims 5-6 separately and the rejection of these claims is sustained for the same reasons as claim 1.

Claims 7, 28, and 31-32

The Appellants argue that the rejection of claim 7 is improper because Schena and Kocher do not teach or suggest "a removable memory medium (for storing machine readable information representative of a scanned product code symbol) in a portable consumer good . . . that can be removed . . . and inserted into an internet ready device" (Br. 7-8).

In contrast the Examiner has determined that Schena would have been obvious to combine with the removable memory of Kocher to provide an old and well known option (Ans. 4).

We agree with the Appellants. Claim 7 includes limitations requiring:

(2) a removable memory medium to which said information is stored; and

b) an *Internet-ready device couplable to one or more Internet-based information servers*, said Internet-ready device including a removable memory medium *adapted to accept said removable memory medium from said scanning and storage device . . .*

(Claim 7, emphasis added).

Schena and Kocher do not disclose an Internet-ready device couplable to an Internet-based information server or adapted to accept a removable memory medium from said scanning and storage device (FF4, FF7). While claim 1 above can be read broadly enough to simply require a “removable memory medium” with the other claimed elements here claim 7 includes a further limitation requiring “an Internet-ready device...adapted to accept said removable memory medium from said scanning and storage device.” This requirement for an Internet-ready device adapted to accept the removable storage medium from the scanning and storage device narrows the scope of claim 7 and is not shown in Schena or Kocher (FF4, FF7). There is insufficient articulated reasoning for combining Schena or Kocher to meet the claimed limitations because neither reference discloses removable memory with the stored UPC information accepted into an Internet-ready device. For these reasons the rejection of claim 7 under 35 U.S.C. § 103(a) as unpatentable over Schena and Kocher is not sustained.

Claim 28 includes a similar limitation requiring:

storing the scanned bar code in the removable memory; transferring the scanned bar code from the removable memory to a computer network; and

accessing a web site on a computer network based on the scanned bar code, wherein said web site includes information related to the selected consumer product

(Claim 28, emphasis added).

Claim 28 also requires more than just “removable memory” as disclosed by Kocher. Claim 28 is a method claim which includes a limitation that requires that the scanned bar code in removable memory be transferred to a computer network, and then the accessing of a web site on a computer network based on the scanned bar code. This limitation is not disclosed by Schena or Kocher (FF4, FF8) and there is insufficient articulated reasoning for combining Schena or Kocher to meet the claimed limitations because neither reference disclose the bar code being used to access a web site as claimed. For these reasons the rejection of claim 28 under 35 U.S.C. § 103(a) as unpatentable over Schena and Kocher is not sustained. The rejection of claims 31-32 is not sustained for these reasons as well as they depend from claim 28.

CONCLUSIONS OF LAW

We conclude that Appellants have failed to show that the Examiner erred in rejecting claims 1 and 5-6 under 35 U.S.C. § 103(a) as unpatentable over Schena and Kocher.

We conclude that Appellants have shown that the Examiner erred in rejecting claims 7, 28, and 31-32 under 35 U.S.C. § 103(a) as unpatentable over Schena and Kocher.

DECISION

The Examiner's rejection of claims 1 and 5-6 is sustained. The rejection of claims 7, 28, and 31-32 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

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